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Paper No. 5

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OFFICE OF PETITIONS

In re Application of :
James McFaddin et al. :
Application No. 10/077,282 : **DECISION REFUSING STATUS**
Filed: February 14, 2002 : **UNDER 37 CFR 1.47(a)**
Attorney Docket No. 694231/0011 JD/JFD :

This is in response to the petition filed October 11, 2002 under 37 CFR 1.47(a) and request for a five month extension of time, in response to the Notice to File Missing Parts mailed March 13, 2002.

The petition under 37 CFR 1.47 (a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on February 14, 2002 as a continuation of parent Application No. 09/859,562, without an executed oath or declaration. Accordingly, on March 13, 2002, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and surcharge for its late filing. In reply, the instant petition, petition fee and extension request were filed. Additionally, a declaration naming James McFaddin, Justin Madison and Michael D. Bigby as joint inventors was provided. The declaration was executed by joint inventors Madison and Bigby on behalf of themselves and on behalf of joint inventor James McFaddin.

Petitioners provide, *inter alia*, copies of E-mail correspondences between petitioners and joint inventor McFaddin wherein joint inventor McFaddin explicitly refuses to sign the declaration in Application No. 09/859,562.

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(3) the petition fee;

(5) a statement of the last known address of the non-signing inventor.

If however, status under 37 CFR 1.47 had been accorded in application no. 09/859,562 and McFaddin did not later join in the filing of the application by executing an oath or declaration for that application, and another application (a child application) such as this application, 10/077,282 is later filed claiming the benefit of the filing date of the parent application and using the declaration of the prior application, status under 37 CFR 1.47 would continue to exist in the child application. That is not the case. Petitioner's assertion in the Declaration of James J. DeCarlo in support of the Petition under 37 CFR 1.47 (a), that the present application is a continuation of patent application no. 09/859,562 and comprises the same specification, drawings and claims does not take the place of a showing that a copy of the application papers in 10/077,282 (specification, including claims, drawings, if any, as well as the declaration) was ever sent or given to McFaddin. Petitioners should provide a copy of the cover letter transmitting **the application papers** to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned
Petitions Attorney at (703) 305-4497.

A handwritten signature in cursive script, reading "Patricia Faison-Ball". The signature is written in black ink and is positioned above the printed name and title.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy